



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,189	07/13/2006	Naum Simanovsky	26979U	7301

20529 7590 09/03/2008
NATH & ASSOCIATES
112 South West Street
Alexandria, VA 22314

EXAMINER

SIGLER, JAY R

ART UNIT	PAPER NUMBER
----------	--------------

3733

MAIL DATE	DELIVERY MODE
-----------	---------------

09/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 23-28, 30, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 23, line 1, the language "said anchor" renders the claim indefinite.

In the independent claim 22 "at least two anchors" is being claim, therefor it is unclear which of the two anchors is being claim. The language will be considered to be "said at least two anchors comprise anchoring means" for further examination.

- b. Claim 30 recites the limitation "said clasping member" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 30 should depend from claim 25 instead of claim 23 in order to provide proper antecedent for "said clasping member" and will be considered as such for examination purposes.

- c. Claim 31 recites the limitation "said hook" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 31 should depend from claim 24 instead of claim 22 in order to provide proper antecedent for "said hook" and will be considered as such for examination purposes.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 22 rejected under 35 U.S.C. 102(b) as being anticipated by US 4,448,191 to Rodnyansky et al. (previously cited; hereinafter “Rodnyansky”).

d. Concerning claim 22, Rodnyansky discloses a plate 1 and at least two anchors (5 with 6 and 8; 13 with 16 and 17). The plate is made of a material having inherent springiness (see col. 7, l. 44). With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Rodnyansky which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Art Unit: 3733

e. Concerning claims 23-28 and 30-33, the anchor has anchoring means (teeth of 5; hook of 13) and connecting means (6 and 8; 16 and 17); 13 is a hook; 5 with 6 and 8 is a clasping member; 6 and 16 are screws; 8 and 17 can be considered a connecting plate; clasping member is shown clasping the spinous process in Fig. 1; the hook is capable of clasping the transverse process; the length of the plate is considered capable of the claimed limitation (see Fig. 1); and the plate has a sheet-like form.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rodnyansky. Stainless steel was a known material at the time of the invention in the art suitable for implantation into the body. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the invention of Rodnyansky out of stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

7. Applicant's arguments with respect to claims 22-33 have been considered but are moot in view of the new ground(s) of rejection.

8. It is pointed out though that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3733

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAY R. SIGLER whose telephone number is (571)270-3647. The examiner can normally be reached on Monday through Thursday from 8 AM to 4 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. R. S./

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733